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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
|-----------------|-------------|----------------------|---------------------|

09/046, 784 03/23/98 CARTER

K 83000.1007

022804  
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TM02/0516

EXAMINER

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

2173  
DATE MAILED:

05/16/01

*21*

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

|                              |   |                               |
|------------------------------|---|-------------------------------|
| <b>Office Action Summary</b> | Application No.<br><b>09/046,784</b>    | Applicant(s)<br><b>Carter</b> |
|                              | Examiner<br><b>Crescelle Dela Torre</b> | Art Unit<br><b>2173</b>       |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)  Responsive to communication(s) filed on Mar 12, 2001

2a)  This action is FINAL. 2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

**Disposition of Claims**

4)  Claim(s) 1-23 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-23 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved.

12)  The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a)  All b)  Some\* c)  None of:

1.  Certified copies of the priority documents have been received.

2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

15)  Notice of References Cited (PTO-892)

18)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

16)  Notice of Draftsperson's Patent Drawing Review (PTO-948)

19)  Notice of Informal Patent Application (PTO-152)

17)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

20)  Other: \_\_\_\_\_

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### **DETAILED ACTION**

1. This action is responsive to communications: Amendment, filed on 3/12/01.

This action is final.

2. Claims 1 - 23 are pending in this application. Claims 1, 7, 12, 17, and 23 are independent claims.

3. The present title of the invention is "Method and Apparatus for Selecting Attachments" as filed originally.

#### ***Claim Rejections - 35 USC § 112***

4. Claims 1 - 6 and 12 - 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In the Amendment, filed on 3/12/01, applicant included a clean copy of the claims, but did not include a marked up copy of amended claims. Based on a comparison of the present Amendment, and an Amendment, filed on 10/30/00, it appears that claims 1, 12, and 17 were amended to delete reference to "attachment to an e-mail message". However, each of these claims is labeled as "twice amended", similar to the Amendment, filed on 10/30/00. In addition,

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applicant's primary argument in the present Amendment is that the combination of Borman and Kelley do not describe "attaching to an e-mail message an attachment associated with a selected portion of a current data resource". Should claims 1, 12, and 17 each include reference to "attachment to an e-mail message"?

***Claim Rejections - 35 USC § 103***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1 - 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borman et al. (U.S. patent 5,890,172) in view of Kelley (U.S. patent 6,078,921).

As per claim 1, Borman et al., hereinafter Borman, teach the following subject matter: a browsing mechanism, with browser interface 400, at Figs. 5A - 5C, and col. 7, lines 52 - 53, configured to render a current data resource, i.e., a file retrieved by the browser, and to navigate through plural data resources, using the Back 412, Forward, and Home 414 buttons; and an attachment mechanism, using jumper window 300, at Fig. 3, configured to retrieve an attachment from the browser in response to a user event, i.e., by a selecting a hot-link with a mouse, at col. 6, lines 55 - 60, the attachment associated with the current data resource, since the "hot-links are extracted from a file initially retrieved by the browser".

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Regarding claim 1, Borman describes that in another embodiment, “the user will be able to invoke the product from within their electronic e-mail box simply by double-clicking on attached files” at col. 12, lines 62 - 64. However, Borman does not specifically teach attaching the attachment to an e-mail message. Nor does Borman specifically teach a selection mechanism to select a portion of a current data resource.

On the other hand, Kelley teaches a method for selecting a portion of a current data resource in response to user input, at Fig. 6C, and col. 7, lines 16 - 30, which results in a “single file that can be used to store and view multi-part files” and create a “single attachment of multi-part files in an e-mail system”, at col. 7, lines 38 - 41. For example, Kelley teaches that the combined file “can be coupled to a e-mail message” at col. 7, lines 41 - 42.

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to attach a portion of a current data resource to an e-mail message as taught by Kelley in the invention of Borman because it allows a user to “convert multi-part files into a single file for use and transfer” at col. 4, lines 19 - 20.

Borman teaches that the attachment comprises a resource locator [claim 2] at col. 7, lines 62 - 63, or source data [claim 3] associated with the current data resource at col. 13, lines 32 - 38.

Kelley teaches selecting an attachment type [claim 4] at Fig. 6C, and col. 7, lines 34 - 35. Furthermore, Borman teaches that the attachment mechanism comprises a button [claim 5] with refresh/update button 326, at Fig. 3, and col. 7, lines 17 - 19. As to claim 6, Borman teaches

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navigating to a first data resource, in browser window 406, using a resource locator, with hot-link 580, in a second data resource, in jumper window 300, all at Fig. 6.

Regarding claims 7 - 11, they are similar to claims 1, 4, 2, 3, and 6. Claims 12 - 16 correspond respectively to claims 7 - 11; while claims 17 - 19, 21, and 23 correspond to claims 1 - 3, 6, and 1.

As per claim 20, the first part is similar to claim 4, while the second part is taught by Borman with site window 404, at col. 7, line 32, and at Fig. 5A, which allows a user to select the property value by entering the site location.

As to claim 22, Borman teaches the following:

a stack configured to contain resource locators of navigated data resources, with history creation process 712, at Fig. 7, and col. 9, lines 40 - 42; and  
one or more methods configured to browse navigated data by stepping forward or backward within the stack, at col. 9, lines 43 - 56.

### *Response to Arguments*

7. Applicant's arguments filed 3/12/01 have been fully considered but they are not persuasive.

Applicant's primary argument regarding the combination of Borman and Kelley is that they do not describe "attaching to an e-mail message an attachment associated with a selected portion of a current data resource". The examiner does not agree because Kelley teaches selecting a portion of a data resource, at Fig. 6C, and col. 7, lines 16 - 30, wherein the "data

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resource" is represented by the source folder, and the "selected portion" is represented by the selected files contained within the source folder.

*Conclusion*

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

*Responses*

9. Responses to this action should be mailed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231. If applicant desires to fax a response, (703) 308-9051 may be used for formal communications or (703) 305-9731 for informal or draft communications.

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Please label "PROPOSED" or "DRAFT" for informal facsimile communications. For after final responses, please label "AFTER FINAL" or "EXPEDITED PROCEDURE" on the document.

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

*Inquiries*

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Crescelle dela Torre whose telephone number is (703) 305-9782. The examiner can normally be reached on Mondays-Thursdays from 8:30 am to 4:00 pm, and on alternating Fridays from 8:30 am to 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca, can be reached at (703) 308-3116.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3800.

*C. dela Torre*  
CRESCELLE N. DELA TORRE  
PRIMARY EXAMINER

5/14/01